IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. 446

CREST SPECIALTY (NOT INC.), A LIMITED PARTNERSHIP CONSISTING OF BEN B. MANASTER, ROSE MANASTER, CAROL RUTH MANASTER, AND SOL ELIOT,

Petitioner,

vs.

DAVID C. TRAGER, DOING BUSINESS AS TOPIC TOYS, AND EOINA NUDELMAN, AN INDIVIDUAL,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

BRIEF FOR RESPONDENTS.

OPINIONS BELOW.

The Findings of Fact and Conclusions of Law of the District Court (Hon. Michael L. Igoe, District Judge, R. 111-118)* are reported in 89 F. Supp. 199.

---

* References in this brief will be abbreviated as follows:
Transcript of Record—"R. ....."
Finding of Fact—"F. F. ....."
Petition for Certiorari—"Pet. ....."
Brief for Petitioner—"Pet. Br. ....."

The opinion of the Court of Appeals for the Seventh Circuit (R. 188) was prepared by the Honorable Walter C. Lindley, Circuit Judge, and was concurred in by the Honorable Otto Kerner and F. Ryan Duffy, Circuit Judges; it is reported in 184 F. 2d 577.

JURISDICTION.

The judgment of the Court of Appeals was rendered on October 16, 1950 (R. 188). The petition for a writ of certiorari was filed on December 8, 1950, and was allowed on February 26, 1951 (R. 198).

The jurisdiction of this Court is invoked under 28 U. S. C. § 1254 (1).

QUESTION PRESENTED.

This is an ordinary patent infringement action in which the courts below unanimously concurred in holding that claims 2 and 3 of Nudelman patent No. 2,455,266, issued November 30, 1948, for a "Children's Amusement Device," are valid and have been infringed by petitioner.

Petitioner did not raise any question in the petition for certiorari with respect to infringement (*cf. Crown Cork & Seal Co.* v. *Gutmann Co.*, 304 U. S. 159, 161; *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U. S. 175, 179), and, therefore, the only question now before the Court is:

Are claims 2 and 3 of Nudelman patent No. 2,455,266 valid?

STATEMENT.

Petitioner's "Statement of the Case" reflects only the view of the facts which was advanced unsuccessfully in the courts below and wholly ignores the findings of fact made by the trial court and concurred in by the Court of Appeals. We accordingly briefly restate the case:

This action was brought by respondents in the United States District Court for the Northern District of Illinois to enjoin infringement of Nudelman patent No. 2,455,266, issued November 30, 1948, for a "Children's Amusement Device" (R. 132), and to recover damages occasioned by petitioner's infringement (R. 2-6).

The device of the Nudelman patent may be described simply as one which provides stimulation for children of tender years to eat. As found by the trial court, Nudelman's device is "an 'eating' table companion" for young children which "serves to encourage and educate them to eat" (F. F. 4, R. 111). It is a figure constructed to simulate a living animal—one readily comprehensible by a child and on his level of perception. It is adapted to be perched at the outside of a child's feeding bowl and has structural means "whereby the device can be fed and the food returned to the bowl" (R. 133, col. 1, ll. 8-12). The device creates the illusion that the little animal figure is actually eating and swallowing, and accomplishes the object for which it was intended by stimulating a child to follow the "eating" companion's example; that is, to mimic the animal's action and hence itself to take food and eat. The concept of this device was found to be new and inventive (F. F. 5, 6, R. 112). Nudelman's patented device is not merely a toy, but, as the trial court found, it is "highly utilitarian in character and has decided educational and psychological value" (F. F. 4, R. 111).*

* Nudelman's device is exemplified commercially by Plaintiffs' Exhibits 3 and 4. It is fully described in Finding No. 4 (R. 111-112) and in the opinion of the Court of Appeals (R. 188-189).

Claims 2 and 3 are in suit. They describe the necessary parts of the animal figure and the manner in which they are adapted to cooperate with a feeding bowl. *A feeding bowl is of course old in the art and is not included in the claims, which are confined to Nudelman's new structure.* This is admitted by petitioner (Pet. Br. p. 4).

It was admitted by Ben. B. Manaster, one of the partners of petitioner, that the infringing device "was copied from the device of the plaintiffs" (F. F. 11, R. 113-114). Indeed, after learning of Nudelman's device, Manaster applied for and obtained a "subsidiary and tributary" patent which covers only a specific type of head connecting means (F. F. 12, R. 114). Petitioner has labeled its infringing device as the "recognized new idea that makes children willing eaters" and has advertised it as an "unusual" item—sparked with "cleverness, color and imagination" (F. F. 10, R. 113).

On the trial, petitioner, nonetheless, sought to prove that Nudelman was anticipated by Smith patent No. 2,207,417 dated July 9, 1940, entitled "Cereal Bowl" (R. 170-172) and relied on it and various other patents to show want of invention as well. Petitioner called as an "expert" witness a patent attorney (R. 35-36) who produced the chart Defendants' Exhibit 2, which appears opposite page of the Brief for Petitioner and, using it to illustrate his testimony, asserted that Smith "completely anticipates" Nudelman (R. 37, 38-41).

The trial court found that Nudelman was new—not anticipated by Smith (F. F. 15, R. 115). In that connection the testimony of petitioner's expert (and with it, of course his chart) dealing with Smith was rejected as "lacking in verity" (F. F. 15(e), R. 116). Nudelman's device was found to be "unique," "ingenious" and a "genuine improvement" over the prior art (F. F. 10, R. 113), and on all the evidence the trial court found that the "concep

tion and production of a device like that shown and described in the Nudelman patent in suit was beyond the skill of a mechanic, and required the exercise of inventive genius" (F. F. 17, R. 117).

The Court of Appeals concurred in the trial court's appraisal of the Nudelman patent and in the rejection of Smith and the other "so far afield" references. Convinced by its own "careful examination of the evidence" that the trial court's findings were justified by "adequate substantial evidence," the court below affirmed the judgment of the District Court (R. 190, 191).

The case is here on a writ of certiorari to review the opinion of the court below upholding the validity of the Nudelman patent.

SUMMARY OF ARGUMENT.

I. Claims 2 and 3 of Nudelman's patent are valid on the facts of this case and under applicable rules of law. Each of the three prerequisites to patentability, *i. e.*, novelty, utility, and invention, is fully established by substantial, credible evidence.

(a) Nudelman's device is "new". It is the first structure providing a child's "eating" table companion to which food may be fed to encourage the child in turn to eat. It is not anticipated by the Smith patent because the partitioned cereal bowl of that patent is utterly unlike Nudelman in structure, has an object in view which is entirely different from that of Nudelman, employs an antithetical operation, and is used under radically different conditions. There is no hint or suggestion in Smith of Nudelman's conception, structure, or mode of operation. What might result from a redesign of Smith's hopper and a relocation of essential parts in the light of Nudelman

is not a valid basis for anticipation. The testimony that Smith's structure anticipated that of Nudelman was rejected by the trial court as "lacking in verity," and petitioner's expert conceded that the statement in Smith's patent of a child's possible interest in its operation was not a suggestion of the Nudelman patent or a teaching of stimulating children to eat by the psychology of mimicry.

(b) Nudelman's device is "useful". There are no degrees of utility under either the Constitution or the patent statutes. Any improvement is a useful one so long as it is capable of performing some beneficial function claimed for it. Nudelman's device meets the tests of utility since it provides a device which some members of society find of benefit on the *level of living*. The evidence overwhelmingly supports the trial court's finding that Nudelman's device is "highly utilitarian," having "decided educational and psychological value." There are no countervailing proofs.

(c) Invention, not mere mechanical skill, was exercised by Nudelman. His concept was brand new. He was the first to apply the principle of mimicry to the problem of infant feeding by the use of a particular, novel, physical structure. Nudelman's device was the first device of its character to aid in the solution of the infants' feeding problem. Nudelman departed from all prior attacks on the problem, attacks which were "abortive" attempts and "fundamentally and basically quite different." The factual historical background is covered by unchallenged findings showing that there was a substantial demand for a device to solve a long-standing problem. That was solved, and a long-felt want was filled, by Nudelman with a device which the trial court found to be unique, ingenious, and a genuine improvement. Petitioner's infringement is sincerest flattery; it admits that the infringing device, copied from Nudelman, is "unusual" and sparked with "cleverness, color and imagination." Petitioner's argument that

form and shape cannot contribute to patentability ignores the functional importance in the Nudelman device of the animal form and the movable head. Unless the device takes on a recognizable form and is able to simulate the feeding process, *i. e.*, have body, head, and mouth, the whole objective fails. Similarly, petitioner's arguments that the rules of *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, and *Great A. & P. Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, require an *a priori* holding of no invention must be rejected. The case at bar is a wholly different one. Here was a new concept, and the device of the patent is not plainly indicated by the prior art; it is not made up of old elements, each performing its old function in the same old way, as was true of the patented devices in the *Cuno* and *A. & P.* cases.

II. The *Cuno* case (314 U. S. 84) did not establish a new, higher, or more exacting, standard of invention. In that case this Court did not, by the use of the phrase "flash of creative genius," intend to do otherwise than reaffirm the *Hotchkiss* case, 11 How. 248, with its classic test of invention, *i. e.*, that "more ingenuity must be involved than the work of a mechanic skilled in the art." The decisions of the court below only rejected false interpretations of the *Cuno* case as having announced a new and more exacting standard of invention than previously existed; they have not departed from this Court's decisions. In *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. 2d 812, the court below fully recognized the classic distinction between invention and mechanical skill. It held that the standard of invention had not changed, but that what had happened was that the test of inventive genius had become more exacting as the aptitude of him whom we call the mechanic was raised. In *Sinclair Co.* v. *Interchemical Corp.*, 325 U. S. 327, this Court in effect agreed with the view expressed in the *Burnside* case that we look to the

fact of accomplishment,—to the quality of the product, and not to the quality of the inventor's mind.

III. Under the provisions of Rule 52(a) F. R. C. P. and the applicable decisions of this Court, the unanimous and concurrent findings of fact of the courts below may not be set aside unless clearly erroneous. The questions of "anticipation" and "invention versus mechanical skill" are questions of fact. A trial court's findings on these matters, especially after balancing credibility, persuasiveness, and weight of evidence, are, "unless clearly erroneous," as conclusive on appeal as is the verdict of a jury.

ARGUMENT.

I.

CLAIMS 2 AND 3 OF NUDELMAN'S PATENT ARE VALID ON THE FACTS OF THIS CASE AND UNDER [illegible] RULES OF LAW.

The three prerequisites to patentability under the patent statute, 35 U. S. C. § 31, Appendix, *post*, p. 53, are (a) novelty, (b) utility, and (c) the attribute of invention. Each exists in the case at bar, being established by substantial evidence under a proper application of the controlling rules of law, as we now show:

The Nudelman Device Is "New"; It Is Not Anticipated by the Smith, or Any Other, Patent or Device.—A patented device is "new," that is to say, "not anticipated," within the meaning of the patent statutes, if it was not known or used in this country prior to the patentee's invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof. 35 U. S. C. § 31.

The defense of lack of statutory novelty,* *i. e.*, "anticipation," involves a comparison of the prior device (or its description and drawings, if patented) with the device of the patent in suit, and it is well settled that in order for a prior patent to constitute an "anticipation" in patent

* The distinction between "statutory novelty" as we treat it in this section and the phrase "patentable novelty" is important and should not be overlooked. The latter phrase is sometimes used as a synonym for "patentability" and really involves consideration of all of the statutory prerequisites, *i. e.*, novelty, utility and invention. On the other hand, statutory "novelty" means only newness (Walker on Patents (Deller's Ed.), pp. 254, 255, § 47; *cf. Collar Co.* v. *Van Dusen*, 23 Wall. 530; *Boston Pencil Co.* v. *Automatic Pencil Sharpener Co.* (2 Cir.), 276 Fed. 910, 912).

law, it must disclose a complete and operative device substantially identical with that of the patent in suit. *Seymour* v. *Osborne*, 11 Wall. 516; *Coffin* v. *Ogden*, 18 Wall. 120; *The Cawood Patent Case*, 94 U. S. 695, 703; *Bates* v. *Coe*, 98 U. S. 31, 48; *Imhaeuser* v. *Buerk*, 101 U. S. 647, 660; *Eames* v. *Andrews*, 122 U. S. 40, 66. Thus, devices are not identical in substance if, having different structures, they accomplish substantially different results or perform different functions. *Seymour* v. *Osborne*, 11 Wall. 516; *Consolidated Valve Co.* v. *Crosby Valve Co.*, 113 U. S. 157, 171; *Consolidated Roller Mill Co.* v. *Walker*, 138 U. S. 124; *cf. Union Paper-Bag Machine Co.* v. *Murphy*, 97 U. S. 120, 125.

A prior device, consequently, cannot serve as an anticipation negativing novelty unless it performs substantially the same function or office in substantially the same way and produces substantially the same result as the device of the patent in suit; and these requirements are not satisfied by a prior device which might by modification be made to accomplish the function performed by the device of the patent in suit if it was not designed by its maker, nor adapted, nor actually used, for the performance of that function. *Clough* v. *Barker*, 106 U. S. 166, 175-176; *Topliff* v. *Topliff*, 145 U. S. 156, 161; *Block* v. *Nathan Anklet Co.* (2 Cir.), 9 F. 2d 311, 312; *Gordon Form Lathe Co.* v. *Walcott Mach. Co.* (6 Cir.), 32 F. 2d 55, 58. Neither may prior art patents be extended beyond their fair meaning, for they are evidence of the prior art only as to what they disclose on their face. *Naylor* v. *Alsop* (8 Cir.), 168 Fed. 911, 920. They must be viewed "without assistance from the patent" in suit. *Cohn* v. *United States Corset Co.*, 93 U. S. 366, 370. They cannot be reconstructed in its light and then used as anticipations. *Downton* v. *Yeager Milling Co.*, 108 U. S. 466, 471; *Eames* v. *Andrews*, 122 U. S. 40, 66; *Skelly Oil Co.* v. *Universal Oil Products Co.* (3 Cir.), 31 F. 2d 427, 431.

SMITH PRIOR ART PATENT NO. 2, 207, 417 (R. 170)

OBJECT: To provide a cereal bowl with two compartments, one compartment for storing and loading dry cereals and the other compartment for receiving milk or cream, the sole purpose being *to avoid intermingling of the cereal with the milk, thereby to maintain the cereal crisp and prevent it from becoming soggy.* The Smith device may be in the form of a single bowl with a dividing partition and an opening in the bottom of the partition (Figs. 1, 2 and 3 of Smith) or it may be formed in two parts, one a bowl and the other a storage bin or hopper inserted *within the bowl* (Fig. 4 of Smith) i.e , "a bowl within a bowl."

Fig. 3

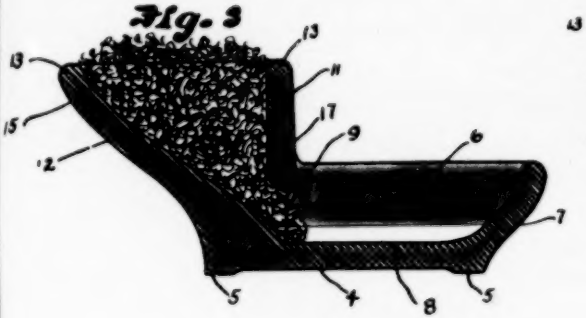
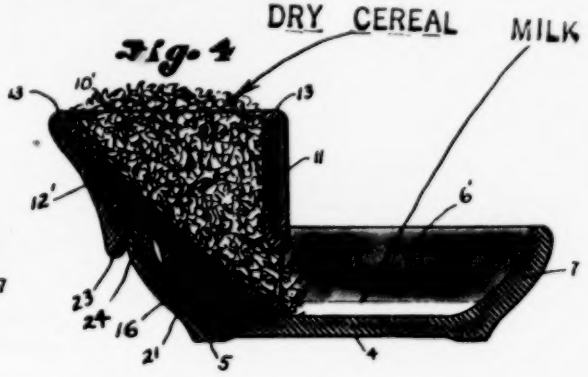


Fig. 4



STRUCTURE:

A device of abstract form having no particular character, such as would stimulate a child to eat.

May be either one bowl partitioned into two chambers (Figs. 1-3) or storage bin within a bowl (Fig. 4).

Storage bin fits *entirely within and rests on bottom of bowl.* Bin has a *bottom extending from one wall to other* and underlying the top opening.

Side outlet opening at bottom of bin.

Never intended that moistened child's food from bowl should be passed through bin, since bin is intended to be initially *filled and loaded with dry cereal.*

Form and position of bottom wall of bin and side outlet will not permit moistened child's food to pass freely through bin, since it would adhere to walls of bin and block the side outlet.

NUDELMAN PATENT IN SUIT NO. 2, 455, 266 (R. 132)

OBJECT: To provide a stimulant for children to eat and to encourage the development of correct feeding habits; to provide an *educational device based on an entirely new concept in child feeding, employing the psychological mechanism of mimicry* by embodying the device in a figure with a movable head simulating a living creature comprehensible to a child to serve as a *"table eating companion"* for the child, suggesting that the figure is actually eating and swallowing, the figure being so constructed that it may be "fed" by the child or its mother, simultaneously with the feeding of the child, with the same food, from the same bowl and with the same spoon, *the food being returned to bowl* through the "eating companion" device.

STRUCTURE:

A readily identifiable figure having a body and movable head comprehensible to a child.
Entire unit *fits adjacent exterior of bowl.*
Only simulated mouth and passage *extends over top rim of bowl.*
Capacity of bowl not reduced. *Short straight downward passage terminates near top of bowl.*
Food passes *freely, immediately and directly through short passage back into bowl from whence it originally came.*
Movable head covers and uncovers simulated mouth to suggest eating and swallowing.

Tested by the foregoing legal principles, the Nudelman device—utterly unlike Smith in structure and diametrically opposed in purpose and function—was clearly "new." It was not anticipated by Smith, either alone or combined with parts or elements from the other prior patent references.

We have prepared and insert opposite this page a chart which graphically depicts the absence in Smith of Nudelman's new structure and inventive concept. The chart consists of enlargements of Figures 3 and 4 of Smith's prior patent (R. 170) and a perspective view of the Nudelman device. In each, we have endeavored to show the intended operation.

A mere examination of the illustrations, particularly Figure 4 of Smith, showing the device on which petitioner relies, discloses why, on the argument in the court below, Judge Duffy aptly termed it a "bowl within a bowl" and why it *is unlike Nudelman in structure and diametrically opposed in purpose and function, having in view an object entirely different from Nudelman's and providing a function entirely foreign to his (F. F. 15, R. 115-116).*

Smith's Figure 4 device may be briefly described as consisting of a bowl having a detached hopper or storage bin positioned inside for separating the cereal and milk. The hopper or bin is between one-third to one-half of the size of the bowl and is placed inside and within the bowl, nesting on its bottom, and correspondingly reducing the capacity and size thereof. The hopper has an angularly inclined wall which extends the full height of the bowl and slopes from one side wall to the opposite side wall of the hopper, thereby forming the bottom or floor of the hopper. The bin has a side opening leading laterally into the bowl. The opening or passage is at the lowermost portion of the hopper and is thus very closely adjacent the bottom of the bowl.

It was the intention of Smith that the hopper should be filled with cereal in the same manner as a storage bin and that the milk should be poured into the bowl. The hopper thus merely serves to separate and keep the cereal from contacting the milk so that the cereal is maintained in a crisp condition until eaten. In eating, the spoon is placed adjacent the side bottom passage to gather the dry cereal that emerges from the bin in measured quantities, the spoon simultaneously taking up some of the milk in the bowl. The user thus eats cereal which is only momentarily saturated with the milk in the spoon.

Petitioner does not contend that the one-piece device shown in Figure 3 of Smith's patent anticipates Nudelman. This destroys petitioner's case, based on Smith, since the device of Figure 4 is the same device as that of the other figure, save that it is constructed in two pieces. Figure 3 is the full equivalent of Figure 4—the identical thing performing the same function in the same way to produce the same result. From Smith's patent (R. 172, col. 1, l. 31, *et seq.*) it appears that the device of Figure 4 is similar in all respects to that shown in Figure 3 except that the hopper is *detachable to facilitate cleaning the dish.* If the device of Figure 3 is not the same as Nudelman, and we think this is conceded, then by what strange process of reasoning can it be said that its twin (Fig. 4) is the same as Nudelman?

While it is true that Smith stated that a child eating cereal would be interested in the movement of the cereal from the hopper into the bowl (R. 171), *it was conceded* (R. 52, 62) *by petitioner's expert that the passage from the Smith patent, quoted at page 9 of the Brief for Petitioner, did not "suggest" the Nudelman patent* (R. 52) *and that he was unable to find in the Smith patent "any teaching to stimulate and encourage infants to eat by*

reason of psychology and mimicry" (R. 52, 62).* Smith's hopper is a geometric form having no life-like characteristic comprehensible at the level of a child's perception which would encourage him in the feeding process. If anything, Smith's device would be psychologically bad for the child to watch during feeding, as was the practice of distracting the child from its food by the mother telling stories and playing with extraneous toys in attempting to hold the child's interest during feeding. The child's attention is drawn away from the food and the eating process.

The avowed purpose of Smith, repeatedly stressed in the patent, is to maintain precooked dry cereals in the hopper or bin *separated* from the milk and thereby to maintain original crispness and to aid digestion by more intensive mastication of food (R. 171, col. 1, ll. 3-25). Thus, Smith's hopper lacks Nudelman's inventive concept; it was not designed or intended to perform the function of Nudelman's device. Smith's object was to store cereals in the hopper, whereas Nudelman's *inventive concept and his operative principle* involve an operation in which *the child's food is taken from the bowl, fed to an animal figure positioned adjacent to but outside the rim of the bowl, and returned to the bowl*, through a simulated mouth and short passage in the forwardly projecting portion of the animal figure, means being also provided to maintain the mouth and passage over the bowl. Petitioner's expert admitted that it is contrary to Smith's express teachings to take spoonfuls of mixed cereal and milk from the bowl and put them back into Smith's hopper (R. 52, 62).** He

* All emphasis in quotations added, except where otherwise indicated.

** Snow, R. p. 62:

"Q. I want to ask you this, is it not contrary to Smith's express teaching to return the mixed cream or milk and cereal to the hopper portion?

"A. Yes."

also admitted that there is no suggestion or hint in the Smith patent of such an operation (R. 52).*

Thus, clearly, from the mouth of petitioner's own expert, it was established that *Smith's device lacked Nudelman's inventive concept and was entirely different from that of Nudelman.* The trial court was, therefore, fully justified in finding that Smith's device was "used under radically different conditions to perform a function quite different from that of the Nudelman device, and it employs an antithetical principle of operation" (F. F. 15(b), R. 116).

Petitioner contends (Pet. Br., pp. 9-10), as it did in the courts below, that Smith "like the Nudelman patent in suit, discloses a passage which, like that of the claimed device, leads to and discharges into a bowl, thus enabling a mother, while using the Smith device in the feeding of a child, to take a spoonful of the contents of the bowl and deposit the same into the passage for gravitation back into the bowl."

This is sheer nonsense and hindsight carried to the extreme. Petitioner's expert admitted that it is contrary to Smith's teachings to use his device in the manner now asserted by petitioner. Furthermore, there is no conceivable reason why anyone (unless he had been so taught by Nudelman) should desire to fill Smith's bowl with mixed cereal and cream and then spoonful by spoonful deposit the cereal into the hopper. Not only is it impossible for Smith to be so operated,** but also that is not what Smith intended. In any event nothing would be

* A case which is made out by cross-examination of an opposing witness is, indeed, a strong one. *Eibel Process Co.* v. *Minnesota Paper Co.*, 261 U. S. 45, 53.

** A demonstration performed in court by petitioner's expert showed his model of Smith to be inoperative, at least for one type of dry cereal, when employed *a la* Nudelman (R. 52-53, *vide* F. F. 15(c), R. 116).

accomplished. The eating process would not have been simulated in accordance with Nudelman's teaching; nor would the child be able to see the food exit from the passage at the bottom of the hopper, which was the operation that Smith thought a child would be interested in. Thus, even if Smith could be operated as suggested by petitioner, the alleged interest-holding feature would be vitiated, and the passage in the patent which petitioner has so enthusiastically lauded (Pet. Br., p. 9) loses all of its possible relevancy.

The trouble with petitioner's contention is, as Mr. Justice Blatchford said of the alleged "anticipation" in *Clough* v. *Barker*, 106 U. S. 166, 176:

> "* * * The structure was not designed for the same purpose as Clough's, no person looking at it or using it would understand that it was to be used in the way Clough's is used, and it is not shown to have been really used and operated in that way."

In order to make Smith operate like Nudelman, as petitioner so baldly assumes, it would be necessary, first, to add a lifelike figure through whose mouth the food could be entered into the hopper, and second, to raise the exit passage of the hopper so that it would not be submerged in the bowl contents.* This would be to redesign and re-

* Even such a modification does not meet the complete Nudelman concept. As so modified, Smith has been converted into a figure standing inside the bowl, and when the food is introduced to the bowl the figure is hence standing partially immersed,—a poor example of proper feeding conditions. What remains to be done, therefore, is to relocate the entire body so that it is positioned adjacent the exterior of the bowl. In making all these changes, Smith has been completely destroyed, and Nudelman, on the other hand, has been transplanted in Smith. It is as plain as it can be that without any knowledge of Nudelman's device, no one could possibly see the Nudelman concept in Smith or even know where to begin to convert Smith into anything like Nudelman. These are reasons why, *inter alia*, as discussed, *post*, pp. 30-35, more than mere mechanical skill was involved in the production of the Nudelman device over Smith.

locate essential parts of the hopper as well as to impose new and different functions upon those parts—in short, to employ them in a manner never contemplated by, and indeed, inconsistent with, Smith's express disclosure. In *Block* v. *Nathan* (2 Cir.), 9 F. 2d 311, 312, Judge Learned Hand said:

> "* * * If any one had reversed it [the prior art structure], he would have perverted it from its plainly intended position; the design of the combination would have cried out against it. An earlier device which must be distorted from its obvious design cannot be an anticipation."

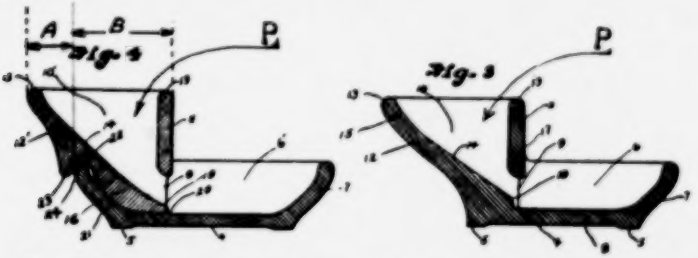
Prior patents cannot be reconstructed in the light of the invention in suit and then used as a part of the prior art.

Defendants' Exhibit 2 Is an Unreasonable and Distorted Application of the Claim Language.—In asserting, on the basis of Defendants' Exhibit No. 2 (Pet. Br., p. 9), that "without exception, every element of typical claim 2 in issue is found, in the same relationship with respect to each other, in the Smith patent," *petitioner is pressing upon this Court the testimony of its expert which the trial court rejected as unworthy of credit* (F.F. 15(e), R. 116-117, *ante*, p. 4).

Petitioner, referring to the chart, says that "identity" is "crystal clear." But this chart is an illusion; it is no more than wishful thinking. It treats the words of Nudelman's claims as though they existed *in vacuo* and uses them out of context, with an utter disregard of the meaning which the law always requires, *i. e.*, that derived in the light of the Nudelman patent specifications (*Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, 217).

According to petitioner's chart, the parts 12′ and 23 of Smith's hopper represent "a body portion" called for in Nudelman's claims, and the part 16 the forwardly ex-

tending portion. We here reproduce the two devices of the Smith patent with a red dividing line added to Figure 4 to illustrate the complete absurdity of petitioner's position.



Credulity is taxed beyond the breaking point by the contention so dramatically shown by the foregoing illustration to be absurdly erroneous, *viz.*, that the small part of Smith's hopper indicated by "A" may be said to be the main, central and principal portion of the hopper and that the considerably larger part indicated by "B" constitutes only a mere appendage thereto. *This is one of the reasons why Judge Igoe rejected the testimony of petitioner's expert as being "lacking in verity" and an "unreasonable distortion of the language of the claim"* (F.F. 15(e), R. 116-117).

According to Nudelman's disclosure, the "body portion" called for in Nudelman's claim, and which is required to be *placed adjacent the exterior of the bowl*, is the body 10 of Nudelman's figure. This is the *main, central, and principal* portion of the animal, and is necessarily so not only in the light of the disclosure, but in accordance with ordinary dictionary definition as well.* From Nudelman's main body portion, the auxiliary or smaller portion, which

* Webster's New International Dictionary defines "body" *inter alia* as "The trunk, or main part (esp. of a person, animal, or plant), as distinguished from the limbs and the head; the main, central, or principal part, as of a tree, army, country, structure, building, etc."

forms the simulated mouth of the figure, projects inwardly or over the bowl and overlies only the top of the bowl.

Another ridiculous and fundamentally erroneous "mere word application" made upon petitioner's chart is that relating to the "passage" called for in Nudelman's claims. According to the Nudelman patent disclosure and drawings, the passage "extending solely downward" from the mouth is not in, or a part of, the main body portion. Nudelman's passage is *short* and *terminates adjacent the top rim of the bowl.* This is essential to carry out Nudelman's concept and functions. Petitioner shuts its eyes to this fact and seeks to use the cubical interior of Smith's hopper, designated by "P," as such a passage. But this interior is the space intended and designed for the storage and confinement of the dry cereal; it is not Smith's passage. Smith's bottom passage is found at 9 and 19, not at P. It is a lateral passage. It is at the side of Smith's hopper and its axis is parallel to the base of the bowl. It terminates *adjacent the bottom of Smith's bowl.*

Moreover, the axis of the short Nudelman vertical passage which *terminates adjacent the top or rim of the bowl is at right angles to the base of the bowl* and thus permits baby food of mush-like consistency—semi-solids—to fall directly from the top outlet of the passage into the bowl without adhering to the sides of the passage and without clogging it. In Smith, the under-wall of the bin P slopes laterally from one side of the bin completely across to the other side, thus forming a bottom or floor for the bin directly under the top cavity. If, contrary to Smith's teachings and purpose, one took food from the bowl and dumped it into the Smith hopper, the food would not pass through the Smith hopper. It would stay in the hopper. This sloping under-wall, extending from one side wall to the other, is in keeping with Smith's desire to handle dry cereals and retain them dry. These only gravitate from

the passage in measured quantities as the spoon scoops away the pile adjacent the side outlet. But if mush-like food or wetted cereal which constitutes the child's diet is dropped into Smith's bin, it will adhere to the sloping bottom wall and eventually block the passage into the bowl; see F.F. 15 (c), R. 116.

Nudelman's inventive concept is fundamentally and basically new and is diametrically opposed to Smith's. Nudelman does not want to separate two foods. His purpose is to provide a "table companion" that "eats" with the child, that utilizes the psychological process of mimicry in stimulating a child to eat, and that teaches the child proper feeding habits. Nudelman's disclosed operative principle requires the body portion, formed to simulate a living creature, to be *outside the bowl.* It requires the auxiliary or projecting portion simulating the mouth to *overlie* and *overhang* the bowl, and the "solely downward" extending passageway is found only in the projecting portion; it is a short passageway and terminates closely adjacent the *top rim of the bowl. The Smith patent does not show this structure.*

The tabulation appearing upon the succeeding page consists of a serialized breakdown of claim 3 of the Nudelman patent (R. 133-134) and quite clearly shows that the device of that claim, as represented by the elements specified (properly interpreted in the light of the specification), is not found in Smith or in the other patents mentioned in Petitioner's Brief, *i. e.,* Trosper patent No. 1,751,773 (R. 152) and Theodoropulos patent No. 1,792,129 (R. 158) *or in any combination thereof.*

Nudelman Claim 3*	Whether Claim Elements Are Present		
	Smith	Trosper	Theodoropulos
An amusement device comprising	Maybe	Yes	No
(1) a figure formed to simulate a living creature,	No	Yes	Yes
(2) said figure comprising a body portion adapted to be placed adjacent the exterior of a feeding bowl,	No	No	No
(3) said body portion having a forwardly extending portion adapted to extend closely adjacent to and overlie a portion only of said bowl,	No	No	No
(4) said forwardly extending portion having a simulated mouth and a passage,	No	No	No
(5) said passage having walls extending solely downward from said mouth through said forwardly extending portion, and	No	No	No
(6) a head secured adjacent said forwardly extending portion,	No	Yes (head only)	Yes (head only)
(7) and movable to permit the contents of a spoon to be emptied into said simulated mouth and fall by gravity into said feeding bowl,	No	No	No
(8) said forwardly extending portion including means preventing lateral movement of said passage from over said bowl.	No**	No	No

Clearly there is no anticipation. If the claim literally construed could be read upon Smith, it would cease to represent Nudelman's actual invention. *Cf. Westinghouse* v. *Boyden Brake Co.*, 170 U. S. 537, 568.

It is submitted that novelty in Nudelman's device is not negatived and that the findings to that effect in the courts below are clearly correct and in accordance with the evidence.

---

* This claim covers explicitly the form shown in Figures 1 to 4 of Nudelman's patent and the commercial embodiment. Claim 2 is a broader claim in that it omits the movable head element. Petitioner likes to use the modified form of Figure 5 of Nudelman's patent because it has an immovable head, and claim 2 because it does not include the movable head, in the vain hope that thereby it can come closer (?) to Smith. Nudelman's claim 2, however, is no more anticipated than claim 3 as is evident from the tabulation above shown.

** Smith shows a hooking means but since hopper and passage are within the bowl at all times, this claim element is not functionally met by Smith.

The Nudelman Device Is "Useful."—The constitutional motive for conferring on Congress the power to grant patents is the "promotion of the progress of science and *useful arts.*" Accordingly the patent statutes (35 U. S. C. § 31) require as a second prerequisite to patentability the attribute of utility.

An invention is "useful," as that term is used in the patent statutes, if it is capable of performing some beneficial function claimed for it. The constitutional standard is, as this Court has held, "to reward those who make some substantial discovery or invention, which adds to our knowledge and makes *a step in advance in the useful arts.*" *Atlantic Works* v. *Brady*, 107 U. S. 192, 200. The limited monopoly permitted by the Constitution is the inducement to evoke "disclosure of advances in knowledge *which will be beneficial to society.*" *Sinclair Co.* v. *Interchemical Corp.*, 325 U. S. 327, 331.

The word "useful" is, therefore, to be given a practical meaning. It was undeniably employed in contradistinction to "useless," "mischievous," "harmful," or "immoral." Any improvement which achieves a beneficial purpose for the good of society or is of some advantage theretofore not realized is a useful one. Whether great or small, it is of utility if an individual finds it of some help or benefit in his or her labors, or if it makes his or her life more livable; in other words, if it is, for society, a beneficial means to any end on the *level of living.*

In *Lowell* v. *Lewis* (C. C. Mass.), 15 Fed. Cas. 1018, 1019, No. 8,568, Mr. Justice Story, while on circuit, thus explained to a jury the legal significance of "useful" as found in the then patent statutes:

> "All that the law requires is, that the invention should not be frivolous or injurious to the well being, good policy, or sound morals of society. The word 'useful,' therefore, is incorporated into the act in contradistinction to mischievous or immoral. For in-

> stance, a new invention to poison people, or to promote debauchery, or to facilitate private assassination, is not a patentable invention. But if the invention steers wide of these objections, whether it be more or less useful is a circumstance very material to the interests of the patentee, but of no importance to the public. If it be not extensively useful, it will silently sink into contempt and disregard."

Justice Story was rejecting the defendant's contentions, in that case, that the patentee was required to prove "general utility" for his pump and that it was not enough that "in some peculiar cases his invention might be applied with advantage."

There are, therefore, no *degrees* of utility under either the Constitution or the patent statutes. All that matters is that the improvement provide some possible benefit or advantage for society. It is not required to be a commercial success, or the best of its kind, or incapable of improvement. Neither is it required to supersede all other existing means of accomplishing the same object or to be a great scientific innovation. The patent statute requirement of being "useful" is satisfied if some members of the public feel that they have learned something from the improvement, or find some benefit or advantage therein on the *level of living.*

That Nudelman advanced the "useful arts," as the statute requires, is found in the psychological basis for his device which takes advantage of the mimetic tendency of the child and applies it to a practical purpose (F.F. 5, R. 112).

Writing "Tops for Today" in the *Chicago Sun-Times* of October 4, 1948, and the *Philadelphia Daily News* of October 21, 1948, Janet Windsor said (R. 74):

> "Do you have a 'reluctant Robert' in your home? A very junior member of the family who just won't eat

a thing unless he's wheedled into downing each bite?

"If every meal involves a battle with baby, you'll be glad to hear there's a new device on the market that should actually end these tiring sessions * * *.

"The whole idea of the set is based on baby's love for mimicry. The 'one for piggy, one for baby' trick is a simple but sound one. If the tot sees the little porky eating without complaint, he will do the same. What he doesn't know is that the food slides right through the pig and back into the bowl * * *.

"* * * Practical mothers won't want to miss this. * * *"

Mrs. Gladys Gerber, mother of two boys, one twenty months and another five years of age, testified in the case at bar of her approving use of the patented device. She had had quite a few feeding problems with her first child, but, in the case of her second child, "no feeding problem" existed because of this "wonderful thing." As to whether she had found the respondents' Hungry Piggy device "of help and useful" in feeding her youngest child, she said (R. 23):

"* * * he is eating the cereals better than the first one did, and that is all I can say, it occupies his interest."

In petitioner's own Manaster patent, the infringing device is said to have the "effect of inducing the child to alternately feed itself and the character, thus stimulating the child to consume its food" (R. 181, col. 1, ll. 13-16), and upon the carton in which the infringing device is sold petitioner proclaims that it is the "recognized new idea that makes children willing eaters" (Plaintiffs' Exhibit No. 2, see also F.F. 10, R. 113).

In addition to what petitioner thought of the Nudelman device, there has been public acceptance of it. Although the extent of petitioner's sales was not adduced on the trial, it appears that respondents' sales in the first year

of business amounted to 191,386 units (R. 68), representing a dollar volume in retail sales between $180,000.00 and $185,000.00 (R. 16).

In another sense, the general utility of the devices here involved appears from the affidavit filed in the Patent Office by petitioner's present counsel where, in speaking of the infringing device, he said (R. 95) that "the public will benefit by the expenditure of moneys necessary to the manufacturing and sale of said device and the resulting commerce * * * as well as the increased employment of labor" in its manufacture.

The fact of infringement likewise establishes utility, *Lehnbeuter* v. *Holthaus*, 105 U. S. 94, 95, and it does not even lie in the mouth of petitioner to deny or question utility, *Boyce* v. *Stewart-Warner Corp.* (2 Cir.), 220 Fed. 118, 126.

The trial court's finding that the device is "highly utilitarian" (F.F. 4, R. 111) is clearly correct.

The Conception and Production of the Nudelman Device Was Beyond the Skill of a Mechanic and Required the Exercise of Inventive Genius.—The third prerequisite to patentability is "invention."

Ever since *Hotchkiss* v. *Greenwood*, 11 How. 248, it has been consistently held that "novelty" and "utility" are not enough to support patentability; that, in addition, the patented improvement must have the quality of invention. This is both a constitutional and a statutory requirement, since the Constitution authorizes the granting of limited exclusive rights only to "inventors," and the statutory provisions expressly refer to a "new and useful" improvement which shall have been "invented."

However, there is neither a constitutional nor a statutory definition or standard of invention. At best, like "proximate cause" in the field of torts, "invention" is an elusive concept.

Passing for the moment the question of whether or not any special order or high degree of invention is required,* it has always been recognized that in order to constitute invention it is necessary that there be an exercise of the inventive or creative faculty. *Hotchkiss* v. *Greenwood, supra; Hollister* v. *Benedict Mfg. Co.*, 113 U. S. 59; *Thompson* v. *Boisselier*, 114 U. S. 1, 11-13. As was stated by Mr. Justice Jackson in *Sinclair Co.* v. *Interchemical Corp.*, 325 U. S. 327, 330:

> "A long line of cases has held it to be an essential requirement for the validity of a patent that the subject-matter display 'invention,' 'more ingenuity * * * than the work of a mechanic skilled in the art'."

Thus, one thing of which we are certain is that invention may not reside in an improvement, however new and useful, which is the product of mere mechanical skill, representing a contribution which could have been made by those skilled in the art to which it relates merely by the routine exercise of that skill. *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 90-92.

It is not always easy to draw the line distinctly between inventive genius and mere mechanical skill. However, it may be safely said that the lowest order of invention is something more than mechanical skill, and the highest degree of mechanical skill is something less than invention. If the contribution was obvious or would readily occur to those skilled in the art to which it related, the inference to be drawn from the facts is that only mechanical skill was involved. *Altoona Theatres* v. *Tri-Ergon Corp.*, 294 U. S. 477, 487. On the other hand, if those skilled in the art did not know how to achieve the result or solve the problem, in spite of a long-felt want, the inference

* In view of petitioner's charge that the court below has consistently rejected a so-called "flash of genius" test laid down by *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, we treat this point separately at *post*, p. 40.

from the facts is that more than the skill of the calling was required. *Loom Co.* v. *Higgins*, 105 U. S. 580, 591; *Krementz* v. *The S. Cottle Company*, 148 U. S. 556, 560; *Hobbs* v. *Beach*, 180 U. S. 383, 392; *Expanded Metal Co.* v. *Bradford*, 214 U. S. 366, 381; *Diamond Rubber Co.* v. *Consolidated Tire Co.*, 220 U. S. 428, 434-5; *Eibel Process Co.* v. *Minnesota Paper Co.*, 261 U. S. 45; *Goodyear Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 279.

Pursuing further the analogy from the field of torts, as negligence is less care than the reasonably prudent man under all of the attendant circumstances should exercise, so is invention more ingenuity, under the attendant circumstances, than a skilled mechanic would exercise. In each inquiry the trier of facts is required to set up a hypothetical person as an intellectual concept whereby to measure failure to exercise due care or failure to achieve invention. The test of due care may seem simpler, but that is so only because daily personal experiences enable the trier of facts to visualize reasonably prudent conduct subjectively. In testing invention, because personal experiences of the trier of facts in the particular field are usually wanting, an objective background whereby to measure invention must be established. Thus, the testimony of expert and fact witnesses is adduced to show the historic setting of the invention, and what is ordinarily to be expected of the skill of the artisan in the particular field, thereby supplying a standard for determining the fact of invention *vel non*. A necessary limitation on all such testimony is that it shall not be predicated on wisdom after the event. *Loom Co.* v. *Higgins*, 105 U. S. 580, 591.

Thus tested, Nudelman's device is seen to be the product of the inventive faculty and not of mere mechanical skill.

Nudelman's was a revolutionary concept. He was the first to perceive the merit of constructing a device which,

taking advantage of the psychological process of mimiery, could serve to encourage and educate infant children to eat. *This conception was new—a basically different approach to the problem.* Nothing like it had ever been suggested or even hinted at. The device was not merely a toy; it was a working tool for the training and education of children.

Nudelman's device was hence the "first device of its character" to aid in the solution of the long-standing infants' feeding problem (F. F. 5, 6, 7, R. 112); it was "unique," "ingenious," and a "genuine improvement" (F. F. 10, R. 113). Its revolutionary character flows from the fact that the prior means and devices (hereinafter described, *post*, pp. 28, 31) which sought to deal with the problem were "fundamentally and basically quite different" from Nudelman's patented device (F. F. 8, R. 113). As pointed out by the Court of Appeals, these devices were "*abortive attempts*" to solve the problem (R. 188).

The Need or Long-Felt Want.—The trial court found as a fact that the infants' feeding problem was a recognized one which had "existed for a long period of time" and that, prior to February 17, 1948 (when Nudelman's patent application was filed, R. 133), "there was a substantial demand for a device like that * * * in the Nudelman patent" (F. F. 7, 9, R. 112, 113).

Market conditions and the existence of a long-felt want or demand prior to 1948 for more satisfactory solutions of the vexing infant's feeding problem were proved, *inter alia*, through Sol Eliot, one of the partners of the petitioner. He testified (R. 24, 25) that he had been in this business for twenty years and was familiar during that period "with the items which were being offered as feeding accessories or feeding toys." Prior to July, 1948, when the petitioner's infringing device was introduced,

Eliot had personally checked the market to determine whether there would be acceptance for the device. Eliot's survey determined that there was "a substantial market" for the device (R. 90), and on the basis of this survey, petitioner concluded that the device merited a proposed initial investment of $55,000.00 (R. 25, 27, 93).

Dorothy Scharle, vice president and merchandise manager of Nat Gavender, Inc., purchasing representatives of a large group of specialty and department stores, testified that prior to the summer of 1948, no "psychological or utility toy" for use in connection with feeding children was available on the market (R. 22).

The Prior Attempts to Solve the Problem.—The prior efforts to deal with the feeding problem consisted, *inter alia*, of decorated drinking cups and knives and forks with handles simulating living creatures, or of dishes and so-called warming plates decorated with nursery figures (Scharle, R. 22).

L'Heureux patent No. 2,200,696, issued May 14, 1940, on an application filed October 11, 1938 (R. 166-168), shows and describes a "Child's Coaxer Dish" which had for its object the stimulation of a "child's interest in eating by providing his favorite comics, nursery rhymes, etc., in the bottom of the dish and which cannot be seen until his cereal or other foods are completely eaten" (R. 167, col. 1, ll. 5-10). The alleged improvement consisted of providing a transparent bottom in combination with a base which facilitated the mounting and substitution of different pictures, it being claimed by L'Heureux that the changes would maintain a child's interest and that by "rousing the child's curiosity as to what lies underneath, he will soon make a game of his eating" (R. 168, col. 1, ll. 10-12).

Ide patent No. 2,224,683, dated December 10, 1940,

entitled "Feeding Method and Article," also recognized the problem and dealt with it in much the same manner as did L'Heureux (R. 174-176).

It is evident that what had escaped the attention of these patentees who were working in this art was the fundamental cause of the problem. Solution did not rest either in merely holding the interest or in arousing the curiosity of the child. Rather, and this is why Nudelman was "fundamentally and basically quite different," it lay in providing a device utilizing the universal instinct of children for mimicry to induce concentration on the eating process and to create the desired behavior pattern. The evidence shows clearly, therefore, that Nudelman departed radically from the prior thinking of those who were giving their attention to providing means for dealing with the infants' feeding problem by appeals to curiosity and by diversions.

The Court of Appeals was clearly justified in characterizing the prior devices as "*abortive attempts*" to solve the infants' feeding problem (R. 188).

Petitioner's argument of no invention has three facets, *i. e.*, (a) that Nudelman's advance over Smith is merely to form his device to simulate a living creature, (b) that the *Cuno* case (314 U. S. 84) precludes a finding of invention, and (c) that the recent *A & P* case (340 U. S. 147) is indistinguishable from the case at bar and likewise precludes a finding of invention.

(a) Forming the Device of the Nudelman Patent in the Similitude of a Living Creature Was Not Mere Form But a Matter of Substance.—Petitioner's elaborate straw man argument based on "form" and "design" is erected upon a distortion by italicized emphasis of respondents' argument and Finding of Fact No. 6 (Pet. Br., p. 10). The trial court did not find that the essence of Nudelman's concept

was mere design or simulation of a living creature. It did find, not on the basis of a statement made in argument, but on the credible evidence, that it was of the essence of the concept that the device "simulate a living creature comprehensible to a child and have *body, head* and *mouth* so that food could *actually be fed* to it, thereby creating the illusion of eating * * *."

The "form" of Nudelman's device in the likeness of a living creature is not the "form" which is condemned in certain negative rules of patentability. Here Nudelman's shape was not an immaterial variation from prior devices. It was the vitalizing factor in the performance of a new function producing a beneficial result. It is essential to the purpose of the Nudelman structure that the device take the form of a living creature in order that the illusion of eating be created. Unless the structure takes on such a recognizable form, the whole objective fails and no useful purpose will be served.

We note that petitioner ignores the inclusion in claim 3 of a movable head to make the illusion of eating more perfect. Obviously a mere hopper of a geometric form with an *open cavity* like Smith's, and having no lifelike character comprehensible to a child, would not teach or encourage a child to eat by the psychological process of mimicry; it would not serve as a "table companion" which eats with the child. Nudelman's concept, therefore, envisioned and disclosed a structure with a definite form comprehensible to a child, namely, a figure formed to simulate a living creature; this creature must have a body and a head. The head may or may not be movable, but preferably it should be movable, for it then could completely cover the mouth opening and hide the passage from the child's view. It would be raised to uncover the mouth opening so that the food could be deposited therein and then closed again to cover the mouth opening, to simulate the effect of eating

and swallowing, thus cooperating with the other elements to accomplish the intended result.

Petitioner assumes its desired conclusion when it asserts (Pet. Br., pp. 10-11) that "Nudelman formed, *as taught by the prior art*,* such old device [of the Smith patent] to simulate a living creature, to attract the interest of a child and *to encourage it to eat by the so-called process of mimicry.*" This bald-faced statement is wholly unsupported by the record and refuted by the findings below. The prior art referred to in Finding of Fact No. 8 had nothing to do with encouraging a child to eat "by the so-called process of mimicry." Nor did Trosper patent No. 1,751,773 (R. 152) make the slightest reference to such a factor for encouraging eating by the child. Trosper relates to a toy or doll for a child to carry about and play with and shows a rubber pouch or sac positioned inside the body of the toy into which food may be dumped. The pouch retains the food and after it becomes filled the body of the toy may be opened, the pouch detached and removed, emptied and again replaced inside the body of the toy. This patent has no relationship to child feeding and is not directed to the objects of the Nudelman patent (F. F. 16, R. 117).

The Theodoropolous patent No. 1,792,129 (R. 158) relates to a combined umbrella holder and purse. It shows a figure of a bird with a cavity which is closed at the bottom and into which a collapsed umbrella may be inserted for transporting. Obviously, the patent has no pertinency whatever to child feeding.

The principle of the "coaxer dish" patents, also referred to by petitioner (Brief, p. 11) is, as we have previously shown, merely to interest the child in uncovering the comics, pictures or decorations at the bottom of the plate. No mimicry is involved in the use of such dishes.

* Emphasis added.

Despite petitioner's reckless statement, the fact is that Nudelman was the first patentee to disclose any device to encourage a child to eat by reason of the child's innate desire to imitate or mimic such action by others (F. F. 5, R. 112).

Nudelman's, therefore, is a basic and pioneer patent. The Nudelman invention is not merely an improvement, —doing something better, or by other means, than was done previously,—but rather it was fundamentally new. It introduced and utilized a new concept in child feeding, accomplishing something that was never accomplished before and by structure entirely new. Nudelman was the first to provide a structure which (a) utilized the process of mimicry in encouraging a child to eat, and (b) which formed an "eating" table companion for the child, which ate or was fed with the child from the same bowl and spoon and with the same food. None of the prior patents, individually or collectively, show the novel Nudelman concept, function, or structure.

(b) The Cuno Case Does Not Preclude a Finding of Invention.—In the petition for certiorari (p. 11) the question of invention of Nudelman over Smith was said to be controlled by the test of invention announced in the *Cuno* case, despite the fact that the prior art device is "diametrically opposed in purpose and function, having in view an object entirely different from Nudelman's and providing a function entirely foreign to his." No logical or rational demonstration whatever is offered in support of petitioner's position.

The Mead patent in the *Cuno* case was invalidated because (1) "wireless" or "cordless" lighters were old as shown by the prior Morris patent as well as by others (314 U. S. 86), and (2) his automatic or thermostatic control

was likewise old (pp. 88-89). Indeed, the prior Copeland device differed from Mead in some respects, but it was, nonetheless, an electric lighter with a thermostatic control and, hence, all that Mead had done was to use Morris' removable plug to establish the automatically controlled circuit of Copeland.

In the case at bar Nudelman's advance was not plainly indicated as was Mead's. The Smith patent does not compare at all with the prior Morris and Copeland patents in the *Cuno* case; they were not utterly unlike Mead; *they did not have purposes diametrically opposed to Mead's;* and they did not *provide functions entirely foreign* to Mead's. Thus, the *Cuno* case is not one which establishes a negative definition by which it may be ruled *a priori* that no invention is achieved by Nudelman over Smith in the case at bar.

There is no evidence, moreover, of any use for any purpose whatsoever of Smith's device. No one has given evidence that anyone ever regarded Smith as a solution of the feeding problem or even thought of using it in the manner suggested by petitioner (Pet. Br., pp. 9-10). The evidence is quite to the contrary, for petitioner's expert admitted that there is no hint or suggestion of such an operation in Smith and that it is contrary to Smith's express teachings to use his device in the manner of Nudelman (*ante*, p. 13).

Smith's application was filed in 1938 and the patent was published in 1940 (R. 171), and yet it taught the art absolutely nothing concerning utilitarian educational devices to aid in the feeding of children. The conclusion is inescapable that Smith fell far short of the mark and that he taught no one anything as to desirable results. The alleged invention apparently began and ended its uneventful career in 1938 when the application was filed. It was

"stillborn" and it seems to have occurred to no one that Smith's device offered any help in dealing with the problem until this lawsuit was tried and petitioner urged it as an anticipation. In 1948, ten years later, there was still a crying need for a satisfactory feeding device.

Even if it be assumed (contrary to the fact) that Smith's device could be adapted to perform Nudelman's function, that it was not in fact so adapted strongly indicates that the changes were not obvious and involved more than mechanical skill, *Consolidated Valve Co.* v. *Crosby Valve Co.*, 113 U. S. 157; *Potts* v. *Creager*, 155 U. S. 597; *Diamond Rubber Co.* v. *Consolidated Rubber Co.*, 220 U. S. 428; *Trabon Engineering Corp.* v. *Dirkes* (6 Cir.), 136 F. 2d 24.

In the *Consolidated* case, Mr. Justice Blatchford said (pp. 170-171):

> "* * * Taught by Richardson, and by the use of his apparatus, it is not difficult for skilled mechanics to take the prior structures and so arrange and use them as to produce more or less of the beneficial results first made known by Richardson; but, prior to 1866, though these old patents and their descriptions were accessible, no valve was made producing any such results."

But petitioner's present view of Smith is suspect; it is contrary to the opinion held prior to suit. Petitioner then thought Smith lacking in pertinency.* Smith's patent was found when petitioner made a patent search in connection with Eliot's survey of market conditions. However, Eliot admitted that notwithstanding Smith, petitioner proceeded to apply for its Manaster patent No. 2,453,922 (R. 180)

* Petitioner's prior characterization of the infringing device as "unusual" and "sparked with cleverness, color, and imagination" (F. F. 10, R. 113) was also "a frank and apparently a just tribute to the merits" of Nudelman (*cf. Potts* v. *Creager*, 155 U. S. 597, 610.

upon the infringing device. When petitioner's present counsel was petitioning the Patent Office to expedite the Manaster application, he, being then fully aware of the Smith patent, stated under oath (R. 94):

> "I * * * have caused to be made a careful and thorough search of said art * * * and that as a result of said search I believe that said claims define patentability over the prior art. * * *"

Dusted of its years of oblivion, the Smith device has become, according to petitioner and its counsel, "a crystal clear" anticipation of Nudelman and, of course, alleged justification for infringement!

Petitioner admittedly copied Nudelman, not Smith. Like the infringer in *Diamond Rubber Co.* v. *Consolidated Tire Co.*, 220 U. S. 428, 441, it "gives the tribute of its praise to [Smith]; it gives the [Nudelman device] the tribute of its imitation."

(c) This Court's Decision in the A & P Case is Inapplicable.—The case at bar is wholly different from the recent case of *A & P Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147.

In the *A & P* case the lower courts had perceived Turnbull's "invention only in an extension of the counter," each element of the combination having been explicitly found to be "known to prior art." The only thing which had been designated by the two lower courts as an invention had to be disallowed as a matter of law because (a) the extension was not mentioned in the claims except perhaps by a strained construction which ran afoul the claim clarity requirements of 38 U. S. C. § 33, (b) even if the extension were deemed adequately disclosed and claimed, it did not amount to invention merely to elongate a counter, and (c) even if the claims included the extension and it were conceded to be a patentable improvement, over-

claiming existed by reason of inclusion of old elements unless "together with its other old elements, the extension made up a new combination patentable as such."

Having thus determined that the fact finding as to invention could not stand as a matter of law, Mr. Justice Jackson nevertheless proceeded to determine whether the combination could survive on any other basis, nothing tangible being new, and the alleged invention existing "only in bringing old elements together." Under the negative rule of *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 549, the failure of the lower courts to find that the old elements of Turnbull's combination performed "any additional or different function in the combination" than they performed out of it, was fatal to the patent, and this Court concluded on the findings below that the improvement was not patentable. The judgment was accordingly reversed because the lower courts had not used the exacting standard of invention required "where a combination is made up entirely of old components."

In the case at bar, Nudelman's is not a combination made up entirely of old elements. Here we have something new which is tangible; invention was found to reside in the conception and production of the entire assembly—a device which performs a new function and achieves a beneficial result. Being in form and structure a personality on the level of a child's perception, (a) it may be perched at or near the feeding bowl and be fed with the same food as that fed the child and from the same bowl, the food being immediately returned to the bowl without waste, and (b) it creates the apparent appearance of a figure consuming food and by the psychological stimulus of mimicry serves to encourage and educate the child to follow the example of its "eating" table companion. This appears from the following explicit findings as to Nudelman's inventive concept (R. 112):

"5. The inventive concept of Nudelman is well grounded in psychology. It takes full advantage of the process of mimicry, which in the final analysis is the foundation of practically all methods of instruction employed for infant children. The Nudelman device was the first ever to teach the idea of providing an 'eating' table companion for a young child which utilizes the psychological process of mimicry in providing the companion to be fed either by the mother or the child itself simultaneously with the feeding of the child. The feeding of the table companion with the same food and from the same bowl and the apparent appearance of the animal consuming food provides a stimulant for the child to do likewise.

"6. It was of the essence of Nudelman's concept that the device, employed for the purpose of providing instruction and encouragement for the child, simulate a living creature comprehensible to a child, and have body, head, and mouth so that food could actually be fed to it, thereby creating the illusion of eating and thus stimulating, instructing, and encouraging the child to join the 'eating' table companion and to eat."

A device of the foregoing novel character solved a definite problem of long standing (F.F. 7, 8, 9, R. 112-113); it was not obvious and was found to be unique, ingenious, and a genuine improvement; accordingly the evidence fully supports the fact finding that the "conception and production of a device like that * * * in the Nudelman patent * * * was beyond the skill of a mechanic, and required the exercise of inventive genius" (F.F. 17, R. 117).

The factors entering into the standard of invention applicable to the facts in the case at bar appear from the decisions enumerated in Judge Lindley's opinion (R. 190). They may be briefly set forth as follows:

(a) Invention, rather than exercise of mechanical skill, is to be inferred where a device "satisfies an old and recognized want," *Paramount Corp.* v. *American Tri-Ergon Corp.*, 294 U. S. 464, 474.

(b) The fact of accomplishment must be considered, that is, whether the accomplishment was unusual and has the tribute of public approval and imitation by the infringer, and "why [if the infringer had changed from a similar device to that of the patent] was not the change made earlier if the article possessed merit and its production was obvious to a mechanic skilled in the art," *Wahl Clipper Corp.* v. *Andis Clipper Co.* (7 Cir.), 66 F. 2d 162.

(c) The classic tests (1) of *Krementz* v. *Cottle Co.*, 148 U. S. 556, *e. g.*, "obvious advantages over previous structures of the kind," and (2) of the *Expanded Metal* case, 214 U. S. 366, 381, and *Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403, 446, *viz.*, the fact that the improvement was not sooner adopted and used, the failure of skillful persons to see it, "to estimate its value and to bring it into notice," *Pyle Nat. Co.* v. *Lewin* (7 Cir.), 92 F. 2d 628, 630.

(d) A "completely new concept"—no suggestion of anything like the patented device in the prior art and the rule of *Potts* v. *Creager*, 155 U. S. 597, 608, that simplicity perceived after the event is not a criterion of invention, *Peckat Mfg. Co.* v. *Jacobs* (7 Cir.), 178 F. 2d 794.

It is quite clear that, on the facts found, Nudelman's device involved a revolutionary concept and a novel embodiment of that concept which performs a new function, achieves a beneficial result, and was beyond the skill of the mechanic. This is invention.

Although, as we have shown, the facts in the case at bar clearly distinguish the Nudelman patent from the patent involved in the *A & P* case, nevertheless we think that that case is widely misunderstood and misinterpreted, and that its meaning should be clarified. We do not believe that this Court intended in that case to set a standard of invention so high as to be unattainable save to a very few exceptional inventors, because this certainly was never the intent of the Constitution and the Congressional Enactment.

We do not believe that this Court desired in the *A & P* case to destroy the incentive that makes the ordinary run of inventors strive constantly to find new devices which, although not world-shaking, nevertheless improve the lot of mankind, nor to dry up the venture-capital that makes the fruits of such inventors' ingenuity available to the public. We do not believe that this Court desired to give a green light to all those would-be infringers who contribute nothing by their own brains to the progress of science and the useful arts, but who promptly and brazenly pirate the fruits of the struggling inventor's efforts with impunity and who thus lower respect for law, justice and common honesty by their successful escape from retribution.

This country has prospered due in no small measure to the patent system which has encouraged and stimulated individual and often impecunious inventors to strive to invent devices in the "useful arts" that would benefit themselves and therefore benefit society because they would make life a little better and a little easier on the hard level of ordinary, everyday living.

Under our present economy, the patent system is one of the chief safeguards by which the small individual inventor and the small businessman can combine to venture into the making of new products. Firmly entrenched businesses could possibly survive without a patent system, although it is very questionable whether they would be long willing to maintain huge research facilities and to venture forth on new products without adequate protection. But this much is certain,—the individual inventors who comprise the major part and backbone of this country's inventive genius, without patent protection, would have no alternative but to give up the struggle. Their unprotected product, the fruit of their ingenuity and inventive skill, could not be offered by them to prospec-

tive manufacturers for fear that it would be appropriated without compensation. Nor could small businessmen risk pioneering a new product if faced by the certainty that it would be immediately imitated and appropriated by those with more money than scruples. We do not believe that the elimination of the hitherto happy combination of the free-lance inventor and small businessman by restricting patent protection to major inventions only will promote the progress of science and the *useful arts*. A standard of invention should not be established which would cause the patent system to deteriorate to the point where it would benefit only the very rare and exceptional genius.

Nudelman made a noteworthy contribution to an everyday, ever-present, child-feeding problem. He solved this problem, which has existed from time immemorial, by a basically new concept. For the first time he provided a device which utilized the psychological process of mimicry in child feeding. He advanced and succeeded where others had failed. Nudelman's invention is a basic new approach to a problem which was never previously solved. We believe that his invention is of the kind that the patent laws were designed to protect.

II.

THE CUNO CASE (314 U. S. 84) DID NOT ESTABLISH A NEW, HIGHER, OR MORE EXACTING STANDARD OF INVENTION.

Petitioner charges (Pet. pp. 10-13; Pet. Br., p. 11) that the Court of Appeals of the Seventh Circuit has repeatedly rejected the "'flash of genius' test of invention as announced in the *Cuno* case." If it is meant that the classic test of the *Hotchkiss* case (*ante*, p. 24) has been rejected, then we most emphatically deny the charge. If it is meant that the court below has refused to share the belief of

some courts and writers that the *Cuno* case announced a new, higher, or more exacting standard of invention than that of the *Hotchkiss* case, then the charge is true, but it only means that the court below has correctly interpreted and followed this Court's decisions.

If the phrase "flash of creative genius" used in the *Cuno* decision is considered alone, it might, to some, indicate the establishment of a higher standard of invention than that previously existing, but this inference could be justified only by the novelty of the phrase, because substantially the same thought had been expressed in 1885 by Mr. Justice Matthews in *Hollister* v. *Benedict Mfg. Co.*, 113 U. S. 59, when he said that exercising "ordinary faculties" was in no sense "the creative work of that inventive faculty" required.

But when the phrase is read in its context, it must be observed that the initial words of the sentence are "That is to say," and preceding this in the same paragraph is a statement of the classic test of the *Hotchkiss* case, *i. e.*, "more ingenuity must be involved than the work of a mechanic skilled in the art," followed by citation of many cases and a restatement of two negative definitions of patentable invention. That all that was intended in the *Cuno* case was a restatement of the classic test of the *Hotchkiss* case appears as a matter of internal evidence from the respondent's brief in the *Cuno* case. It attacked the *Hotchkiss* decision as unsupported by the Patent Act, and asserted that "novelty" and "utility" were the only statutory prerequisites to patentability. Thus, that brief stated (p. 44):

> "While the word 'invention' connotes originality, it does not involve any idea that a little, or much, genius is required. * * * The degree of ingenuity, we submit, is not the test. Rather, the test is, Is the invention new?"

This Court, reaffirming the *Hotchkiss* case, restated its classic test, and, no doubt, in refutation of Automatic's contention, went on to say: "That is to say, the *new* device, however, *useful* it may be, must reveal the flash of creative genius, not merely the skill of the calling." The opinion concluded with the statement (p. 92):

> "Such considerations [public interest] prevent any relaxation of the rule of the *Hotchkiss* case as respondent would seem to desire."

In view of the slight improvement made by Mead (*ante*, pp. 32-33) and the decision against the patent in the Seventh Circuit (112 F. 2d 335), recourse to a "flash of creative genius" test was not at all necessary. And this Court did not rest its opinion upon any such test; rather, its initial ruling of invalidity, before detailed consideration, was (p. 88):

> "* * * the Mead device was not the result of invention but a 'mere exercise of the skill of the calling,' an advance 'plainly indicated by the prior art.'"

and finally it was said (p. 92) that Mead's adaptation was

> "no more than that expected of a mechanic skilled in the art."

The *Cuno* decision did not, and was not intended to, upset in the slightest the traditional line of demarcation between invention and mechanical skill, *viz.*, that the lowest order of invention is something more than mechanical skill and the highest degree of mechanical skill is something less than invention.

Whether or not a more exacting standard of invention had been or should be established, as suggested in *Picard* v. *United Aircraft Corp.* (2 Cir.), 128 F. 2d 632, was considered by the court below in *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.* (7 Cir.), 132 F. 2d 812. The opinion was rendered by the late Circuit Judge Evan

A. Evans, and was concurred in by Judges Otto Kerner and Walter C. Lindley—all able judges possessing exceptional experience in the field of patent jurisprudence. In sum, the court questioned the use of a "flash of genius test," as a new or higher one or as one which would gain anything by way of certainty or clarity. As a test, "flash of genius" should be rejected, said Judge Evans, because "it is incapable of acceptable definition." The court fully recognized that tests for inventive talent grow more exacting as better education, greater familiarity with machines, and wider experience raise "the aptitude of him whom we call the mechanic." And it expressly acknowledged that patentable novelty or invention required "something more than the skill of the mechanic,"—the classic test of the *Hotchkiss* case, reaffirmed in the *Cuno* case. The court said that it preferred to look to "the fact of accomplishment,—novelty appearing, rather than the method of accomplishment." Judge Evans then stated (p. 818):

> "The questions for the court are: What is the new product? What advance does it show over those in use or known to the art? *Our interest is in the child, not in how or where it was born or who were its parents.* Section 31, Title 35, U. S. C. A.
>
> "*Nowhere in the statute can be found any words which require, or permit us to inquire into the quality of mind or the activity of the mind of the inventor to determine the patentability of his products or processes.* Congress was interested in protecting the product of the mind,—not in whether it came as a flash to the mind or as a happy thought, or by long painstaking search and experimentation."

In finally considering the patented improvement and holding it "not invention," the court said that the conception was "obvious," that one feature was "not beyond the ken or practice of the ordinary mechanic," and that another did not "involve unusual skill,"—all perfectly good traditional tests.

Subsequently, in *Sinclair Co.* v. *Interchemical Corp.*, 325 U. S. 327, 330, this Court in effect accepted Judge Evans' reasoning. Thus, referring to the difficulty experienced in applying the classic test of the *Hotchkiss* case, Mr. Justice Jackson held that its purpose was nevertheless clear, and continuing, he said (pp. 330-331):

> "* * * Under this test, some substantial innovation is necessary, an innovation for which society is truly indebted to the efforts of the patentee. *Whether or not those efforts are of a special kind does not concern us.* The primary purpose of our patent system is not reward of the individual but the advancement of the arts and sciences. Its inducement is directed to disclosure of advances in knowledge which will be beneficial to society; it is not a certificate of merit, but an incentive to disclosure. See *Hartford-Empire Co.* v. *United States*, 323 U. S. 386, 432-433. *Consequently it is not concerned with the quality of the inventor's mind, but with the quality of his product.*"

It is accordingly submitted that there is no basis whatever for the charge that the *Burnside* case announced, and subsequent cases* have applied, a test of invention which is not in harmony with the controlling decisions of this Court.

Circuit Judge Duffy, speaking for the Court of Appeals in the recent *Barie* case (182 F. 2d 724), summed up the court's attitude as to the "flash of creative genius" phrase as follows (p. 727):

> "* * * The Supreme Court has not repeated the much criticized phrase, or otherwise signified that it meant approving such a doctrine as a new test for patentability. The trial court in the case at bar did not particularly emphasize the phrase, except that

* *National Slug Rejectors, Inc.* v. *A. B. T. Mfg. Corp.*, 164 F. 2d 333, *cert. den.* 333 U. S. 832; *Falkenberg* v. *Bernard Edward Co.*, 175 F. 2d 427, *cert. den.* 338 U. S. 870; *Peckat Mfg. Co.* v. *Jacobs*, 178 F. 2d 794, *cert. den.* 339 U. S. 915; *Barie* v. *Superior Tanning Co.*, 182 F. 2d 724.

it was included in a quotation by the court. We shall, therefore, consider that the trial court applied *the correct traditional test*, that is: Did the claimed inventions in the patents in suit involve more than the skill or ingenuity that would be shown by a workman skilled in his line of work?"

Finally, we cannot emphasize too strongly that the court below is not guilty of the charge made on page 12 of the Petition for Certiorari that it is applying a test of invention which differs from that being applied in the Second Circuit,* with the result that manufacturers are hopelessly confused.

Petitioner's indictment of the Court of Appeals for the Seventh Circuit falls flat when we consider the record of the court in its dealings with patents since the *Cuno* case. An examination of the decisions reported since 123 F. 2d starting with November 10, 1941, when the *Cuno* case was decided, to and including the advance sheets for March 12, 1951 (186 F. 2d 744), shows the following:

Patent suits	92
Patents considered	149**
Patents held invalid	98
Patents held not infringed	22
Patents held valid	29

* At page 11 of the Brief for Petitioner, it is asserted that the court below stands alone in the rejection of the "flash of genius" test of invention as announced in the *Cuno* case. Of course, as we have shown, no new or more exacting test was established in that case. But petitioner's "knowledge" is startling. The notion that the *Cuno* case announced a higher standard than that previously existing has also been exploded in: *Brown & Sharpe Mfg. Co.* v. *Kar Engineering Co.* (1 Cir.), 154 F. 2d 48, Cert. Den. 328 U. S. 869; *Trabon Engineering Corp.* v. *Dirkes* (6th Cir.), 136 F. 2d 24; *In re Shortell* (CCPA), 142 F. 2d 292, 295. Confusion is further confounded by petitioner's suggestion at page 12 of the Petition for Certiorari that the *Trabon* and *Shortell* cases are in conflict with an alleged Seventh Circuit rule!

** In addition, the court considered 14 design patents and held each of them invalid.

Thus we see that the court below held only 29 patents valid and infringed out of a total of 149 patents. In other words, 80.54 per cent of the patents before it were held either invalid or not infringed.

Certainly such a high rate of patent mortality completely refutes petitioner's strictures on the court below.

We think it not without some significance, moreover, that the Mead patent invalidated in the *Cuno* case by this Court was previously invalidated by the court below, and that the Anthony and Jones patents upheld by this Court in the *Ray-O-Vac* and *Graver* cases (321 U. S. 275; 336 U. S. 271) had been previously upheld by the court below.

III.

UNDER THE PROVISIONS OF RULE 52(a) F. R. C. P. AND THE APPLICABLE DECISIONS OF THIS COURT, THE FINDINGS OF FACT OF THE COURTS BELOW MAY NOT BE SET ASIDE UNLESS CLEARLY ERRONEOUS.

Rule 52(a) F. R. C. P. provides in part:

> "In all actions tried upon the facts without a jury • • • the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; • • • *Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.* • • •"

In *Graver Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271, 275, Mr. Justice Jackson, referring to the rule, said:

> "The rule requires that an appellate court make allowance for the advantages possessed by the trial court in appraising the significance of conflicting testimony and reverse only 'clearly erroneous' findings. These are manifestly supported by substantial evidence and the Court of Appeals found them supported by the weight of the evidence—indeed found

> the evidence to warrant support of the patent even in matters not found by the trial court. A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error."

Long prior to the adoption of the Rules of Civil Procedure, this Court had held that in patent cases it would not disturb concurrent findings where there was evidence to sustain them. *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405, 416; *Adamson* v. *Gilliland*, 242 U. S. 350, 353. The only exception was in cases brought here because of a conflict of decision in different circuit courts of appeal; in that event, the rule was not strictly applied. *Thomson Spot Welder Company* v. *Ford Motor Co.*, 265 U. S. 445, 447.

Rule 52(a) did not expressly or even impliedly exclude patent cases, and since its adoption this Court has reaffirmed the prior well settled decisional rule. *Graver Mfg. Co.* v. *Linde Co., supra;* see also *Williams Co.* v. *Shoe Mach. Corp.*, 316 U. S. 364, 367; *Goodyear Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275; *Faulkner* v. *Gibbs*, 338 U. S. 267; *The Great A & P Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 153. The qualification previously obtaining in the case of conflicting decisions has also been reaffirmed. *Universal Oil Products Co.* v. *Globe Co.*, 322 U. S. 471, 473.

As pointed out by Mr. Justice Jackson in the *Graver* case, the ultimate question of patentability, *i. e.*, whether the statutory prerequisites of novelty, utility, and invention have been met, is one of law. But the existence or non-existence of each of the requisites is a question of fact. Thus, the question whether a patented device is anticipated or not is one of fact. *Bischoff* v. *Wethered*, 76 U. S. 812, 814-816; *Keyes* v. *Grant*, 118 U. S. 25, 35-36; *Haines* v. *McLaughlin*, 135 U. S. 584, 597-598; *Williams Co.* v. *Shoe*

Mach. Corp., 316 U. S. 364, 367. Likewise, the question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention is a question of fact. *Thomson Spot Welder Co.* v. *Ford Motor Co.*, 265 U. S. 445. Indeed, it is not without significance that the instruction which divided the court in the *Hotchkiss* case, and which resulted in its classic test of invention, had put to the jury the fact determination of whether or not there was "no more ingenuity or skill required to construct the knob in this way than that possessed by an ordinary mechanic acquainted with the business" (11 How. 265).

The older cases in this Court referred to all show that "anticipation" and "inventiveness" were fact questions for the jury under suitable instructions upon the rules of law. Only if clearly against the weight of the evidence was the court authorized to set aside the verdict, but even then the question was still one of fact, not one of law for the court. *cf. Bischoff* case *supra*, p. 814.

In a patent case tried without a jury, the trial court is the trier of fact questions. The fact questions of anticipation and inventiveness require balancing of credibility, persuasiveness and weight of evidence.* A trial court's findings on these facts, "unless clearly errone-

* This is particularly true in the case at bar. Thus the Court of Appeals pointed out, after reference to this Court's decision in the *Graver* case (R. 191):

"* * * Here the court heard the testimony of a number of witnesses, including that of an expert. It expressly found the expert testimony, in certain respects, unworthy of credit. It saw demonstrations of the various devices in court. It passed upon the credibility of the witnesses. It acquired the knowledge that comes from practical demonstration of the two devices. Finally, it made its findings and conclusions of novelty, utility, patentable invention and infringement. To declare them clearly erroneous would be to overturn the trial court's decision upon controverted evidence and to usurp its function of passing upon the creditability of witnesses; this, under the authoritative decisions cited, we are not permitted to do."

ous," are therefore as conclusive upon review as is the verdict of a jury.

A finding of fact is not clearly erroneous unless it is (1) unsupported by substantial evidence, (2) contrary to the clear weight of the evidence, or (3) induced by an erroneous view of the law. As we have shown in the preceding sections of this brief, the concurrent findings of the courts below are not assailable upon any of these grounds.

The conclusiveness upon appeal of fact findings as to the statutory prerequisites to patentability made by a trier of facts was not involved in *Mahn* v. *Harwood*, 112 U. S. 354. The question which Mr. Justice Bradley was considering in that case was whether or not an accused infringer of a reissue patent could interpose a defense not specified by statute (§ 4920 Revised Statutes), such as improper enlargement of claims and unreasonable delay in applying for the reissue. The decree in the Circuit Court had been for the defendant, and upon appeal the plaintiff patent owner was contending that the defense upheld was not available to the defendant,—that the Federal courts were bound by the action of the Patent Office in reissuing the patent. Although holding that the decisions on questions of fact made by the Commissioner were conclusive except as to specific statutory defenses, Mr. Justice Bradley said (112 U. S. 358):

> "* * * But the statutory defenses are not the only defenses which may be made against a patent. Where it is evident that the Commissioner, under a misconception of the law, has exceeded his authority in granting or reissuing a patent, there is no sound principle to prevent a party sued for its infringement from availing himself of the illegality, independently of any statutory permission so to do."

In that connection, and by way of an instance in which

patents issued contrary to law had been held to be void, Mr. Justice Bradley said:

> "In cases of patents for inventions, a valid defense not given by the statute often arises where the question is, whether the thing patented amounts to a patentable invention. This being a question of law, the courts are not bound by the decision of the commissioner, although he must necessarily pass upon it. See *Brown* v. *Piper*, 91 U. S. 37; *Glue Co.* v. *Upton*, 97 U. S. 3; *Dunbar* v. *Myers*, 94 U. S. 187, 197-199; *Atlantic Works* v. *Brady*, 107 U. S. 192, 199; *Slawson* v. *Grand St. Railroad Co.*, 107 U. S. 649, 652; *King* v. *Gallun*, 109 U. S. 99, 101."

It was concluded that where the Commissioner had exceeded his authority in granting or reissuing a patent, such fact "furnishes a good defence to a suit brought for its infringement" and the Circuit Court was affirmed.

Quite plainly, it was not intended in *Mahn* v. *Harwood*, by the observation that "patentable invention" is a question of law, to hold, and it does not remotely hold, that if the trier of facts, *upon credible and sufficient evidence*, finds the existence of the statutory prerequisites, and hence refuses a defense of want of patentable invention, those determinations and the refusal may be reviewed upon appeal as questions of law.

Accordingly, where, as here, the trier of facts found as facts that each statutory prerequisite has been met, the legal conclusion of patentability is inescapable. Unless the findings are clearly erroneous, they are conclusive upon appeal, and a reviewing court may not conclude as a matter of law that patentability is non-existent.

CONCLUSION.

The court below has not improperly applied the law to the facts of this case. The concurrent findings of validity are clearly correct and sound; they are adequately supported by substantial evidence. If the writ is not to be dismissed as improvidently granted (*Layne & Bowler Corp.* v. *Western Well Works*, 261 U. S. 387, 393; *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314, 319), the judgment of the Court of Appeals should be affirmed.

Respectfully submitted,

SIDNEY NEUMAN,
MAX R. KRAUS,
Attorneys for Respondents.